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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,144	12/02/2003	David K. Swanson	03-0117 (US01)	5308
41696 7590 07/13/2007 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070			EXAMINER ROANE, AARON F	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 07/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/727,144	<b>Applicant(s)</b> SWANSON ET AL.	
	<b>Examiner</b> Aaron Roane	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 38-52 is/are pending in the application.
- 4a) Of the above claim(s) 9, 12, 19, 21, 23, 44 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 13-18, 20, 22, 38-43, 45 and 47-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/2/2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 38-43 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Hooven (USPN 6,889,694).

Regarding claims 38 and 47, Hooven discloses a source of coagulation energy (114); a source of stimulation energy (inherent, see col. 15-16); and an apparatus including a clamp (110) having a first clamp member (116), a second clamp member (118), and movement apparatus (140 and 148) that moves at least one of the first and second clamp members relative to the other of the first and second clamp members such that the surgical apparatus has an open state and a closed state, a base member (122 and counterpart for other clamp member) configured to be removably secured to a first clamp member, a support member (totality of 120), the base member being configured to receive the support member, a coagulation element (means for transmitting coagulation energy) (exposed surface of 120) associated with carried by the support member one of

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the first and second clamp members, and a stimulation element (172) (means for transmitting stimulation energy) associated with carried by the support member, see col. 11, 12, 15 and 16 and figures 1, 28-37 and 66.

Regarding claims 39-43, Hooven discloses the claimed invention, see col. 11, 12, 15 and 16 and figures 1, 28-37 and 66.

Regarding claims 48 and 49, Hooven discloses the base member support device includes a mating structure (underside of 122) configured to mate with the first clamp member, wherein the base member support device mating structure comprises a relatively narrow portion (portion of 122 underside adjacent exposed surface of 120) and a relatively wide portion (portion of 122 underside adjacent 134), see col. 11-14 and figures 1, 28-37 and 66.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10, 11, 13-18, 20, 22 and 47-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al. (USPN 6,277,117) in view of Nezhat (USPN 6,162,220).

Regarding claims 1, 14 and 47, Tetzlaff et al. disclose a clamp device comprising a clamp including a first clamp member and a second clamp member (22 and 24), and movement apparatus (collectively 16, 18, 11, 12 and 25) that moves at least one of the first and second clamp members relative to the other of the first and second clamp members such that the surgical apparatus has an open state and a closed state; a base member (111) configured to be removably secured to at least one of the first and second clamp members; a support member (collectively 107, 115, 116, 119 and 155), the base member being configured to receive the support member; a coagulation element (means for transmitting coagulation energy) (116) carried by the support member, see col. 4-6 and figures 1-7. Tetzlaff et al. fail to disclose a stimulation element carried by the support member. Nezhat discloses a bipolar forceps device and teaches providing the electrodes (coagulation elements) (means for transmitting stimulation energy) (274, 276, 278 and 280) with stimulation electrodes (282, 284, 286 and 288 respectively) in order to penetrate into the tissue and deliver electrical energy, see col. 6-8 and figures 1A-3B. It should be noted that the combination provides stimulation elements carried by the support member. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Tetzlaff et al., as taught by Nezhat, to provide the coagulation elements with stimulation electrodes in order to penetrate into the tissue and deliver electrical energy.

Regarding claims 2, 3, 48 and 49, Tetzlaff et al. further disclose the base member support device includes a mating structure (collection of detents 112) configured to mate with the

first clamp member, wherein the base member support device mating structure comprises a relatively narrow portion and a relatively wide portion, see col. 6, line 66 through col. 7, line 17 and figures 1-7.

Regarding claims 4-8, 15-18, Tetzlaff et al. in view of Nezhat disclose the claimed invention, see figures 1A-3B in Nezhat.

Regarding claims 10, 20 and 50, Tetzlaff et al. in view of Nezhat disclose in claim invention, see element 60 of Tetzlaff et al. for support.

Regarding claims 11 and 51, Tetzlaff et al. in view of Nezhat disclose in claim invention, see figures 1A-3B of Nezhat.

Regarding claims 13, 22 and 52, Tetzlaff et al. in view of Nezhat disclose the claimed invention, see the other jaw member assembly (120) and its various analogous counterparts in figures 1-7.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooven (USPN 6,889,694).

Regarding claim 45, Hooven discloses a second base member removable with the second clamp member, a second support member and a second coagulation element, see col. 11,

12, 15 and 16 and figures 1, 28-37 and 66. Hooven is silent as to a second stimulation element. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to pacing electrodes on the second jaw member, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8, 10, 11, 13-18, 20, 22, 38-43, 45 and 47-52 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aaron Roane  
July 6, 20073

*A.R.*

*Roy D. Gibson*  
ROY D. GIBSON  
PRIMARY EXAMINER